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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/301,507	04/28/1999	MAX CYNADER	230018.401C1	5640

500 7590 10/24/2002

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EXAMINER

MARTINELL, JAMES

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 10/24/2002

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/301,507

Applicant(s)

CYNADER ET AL.

Examiner

James Martinell

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 October 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

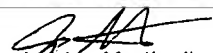
NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): none.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 57-62.Claim(s) withdrawn from consideration: 1-7 and 23-56.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 22.
10. ☒ Other: Appendix I (alignment of SEQ ID NO: 74 and Chen et al)


James Martinell
Primary Examiner
Art Unit: 1631

Art Unit: 1631

Both Chen et al (Nature Genetics 1: 204 (1992) and Berger (Acta Anat. 162: 95 (1998) are discussed here. No copy of an alignment of SEQ ID NO: 74 of the instant application and any sequence disclosed or discussed in Berger is in this record. No copy is seen in the response of March 2002 nor in the response filed October 18, 2002.

Applicants' argument and assertion (see paper no. 15, filed March 22, 2002, page 3 and paper no. 21 filed October 18, 2002, page 2) that SEQ ID NO: 74 shares significant homology with the Norrie Disease gene (paper no. 15) and corresponds to the Norrie Disease gene (e.g., paper no. 21) is not convincing. Berger at page 96 (last sentence of last full paragraph) states that the gene disclosed by Chen et al (Nature Genetics 1: 204 (1992) is a strong candidate for the Norrie Disease gene. The alignment of SEQ ID NO: 74 with the gene disclosed in Chen et al (see the copy of the alignment attached to this Office action) reveals that SEQ ID NO: 74 is only 23.5% similar along its entire length to the sequence of Chen et al and that there is no reasonable alignment to be made from position 125 to 336 of SEQ ID NO: 74 with the sequence of Chen et al. Thus, only about a third of SEQ ID NO: 74 aligns with Chen et al. Thus, applicants' conclusion that SEQ ID NO: 74 either represents or corresponds to the Norrie Disease gene is not convincing and the rejections of claims 57-62 under 35 U.S.C. §§ 101 and 112 stand.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (703) 308-0296. The fax phone number for Examiner Martinell's desktop workstation is (703) 746-5162. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 305-4028. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Art Unit: 1631

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



James Martinell, Ph.D.
Primary Examiner
Art Unit 1631